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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,869	08/25/2003	Kang-heuy Lee	1293.1837	1669

21171 7590 05/30/2006  
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EXAMINER

BODDIE, WILLIAM

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/646,869

Applicant(s)

LEE, KANG-HEUY

Examiner

William Boddie

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In an amendment dated, March 27<sup>th</sup>, 2006, the Applicant amended claim 13. Currently claims 1-21 are pending.

### ***Response to Arguments***

2. On page 6 of the amendment, the Applicant notes that claims 7 and 18 were missing from the Ohyama 102 rejection. This was an inadvertent mistake by the Examiner, it was intended that claims 7 and 18 be solely rejected under 35 U.S.C. 103 as was done later in the previous Office Action.
3. Applicant's arguments filed March 27<sup>th</sup>, 2006 have been fully considered but they are not persuasive.
4. On page 7 of the amendment, the Applicant argues that any person skilled in the art would consider a menu operation a "major function" as opposed to an "additional function." The reasoning for this stance, according to the Applicant, is that a menu key is included on almost any remote control used to operate modern AV equipment. The Examiner respectfully disagrees.

Simply stating that because a menu button is located on most remotes and is therefore a major function is immaterial. The only required limitations, with regards to additional information, are that additional function information be displayed and performing additional functions based on selected additional function information. As shown in the previous office action the invention of Ohyama does exactly that. Simply because Ohyama labels the button "Menu" does not overcome the fact that Ohyama

Art Unit: 2629

displays additional function information (e.g. fig. 12) and performs additional functions (e.g. auto program) based on selected additional function information.

5. The Applicant further argues, on page 7, that fewer steps are necessary in the process of performing additional functions in the current invention over the invention of Ohyama.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., a number of steps in causing additional functions to be performed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the Applicant's flowchart of operation, shown in figure 3, appears to be nearly identical to the flow of operation disclosed by Ohyama in figures 2a-2c (see col. 7, line 45 – col. 9 line 62 for discussion of fig. 2b).

In short under the broadest interpretation of claim 1 there are no clear limitations concerning how frequently used the additional functions are, how often they appear on remote controls, or the exact number of steps it takes to perform an additional function.

6. The Applicant further argues, on page 7, that Ohyama does not divide functions into major and additional functions. The Examiner once again respectfully disagrees.

Ohyama clearly divides the functions of the TV. Note the inclusion of channel changing and volume changing buttons on the remote of Ohyama in figure 21.

However, nowhere on Ohyama's remote do you find buttons for altering the brightness

of an image or setting the time zone for the TV timer. These options are included within the menu structure. It is exactly this difference that shows Ohyama differentiating between *major* and *additional* functions.

7. Applicant claims, on page 8, that due to the dependence of claims 2-12 on claim 1 they are patentable over Ohyama. As shown above claim 1 is not seen as patentably distinguishable over Ohyama. Therefore the rejections of claims 2-12 are maintained.

8. On page 8, the Applicant argues amended limitations to claim 13 that are similar to those discussed in claim 1. Specifically that Ohyama does not disclose displaying information for available additional functions if the remote control signal contains a request for displaying that the additional function information. The Examiner, once again, respectfully disagrees.

Ohyama clearly determines if the signal from the remote control is a request for displaying additional function information (col. 6, lines 40-48). Furthermore, upon that determination, if affirmative, the CPU displays information for the available functions similar to those in figures 7-15 (col. 6, lines 49-66).

9. Applicant claims, on page 8, that due to the dependence of claims 14-19 on claim 13 they are patentable over Ohyama. As shown above claim 13 is not seen as patentably distinguishable over Ohyama. Therefore the rejections of claims 14-19 are maintained.

10. The Applicant further argues, on page 8, that claim 20 is patentably distinguishable over Ohyama, for the same limitations cited in the argument concerning claim 1, above. As shown above, it is the Examiner's position that Ohyama clearly

discloses the claimed limitations of claim 1. Therefore the rejection of claim 20 is maintained for the reasons stated above and in the prior Office Action.

11. On pages 8 and 9, the Applicant argues that Ohyama does not teach "the feature of causing an additional function to be performed in response to the remote control signal containing a request to display the additional function information," and therefore claim 21 is patentably distinct over Ohyama.

The Examiner once again respectfully disagrees. As clearly shown in the previous Office Action, Ohyama discloses causing an additional function to be performed in response to the remote control signal containing a request to display the additional function information (col. 6, line 54 – col. 7, line 32).

12. Finally on page 9, the Applicant traverses the rejections of claim 7 and 18 on the grounds of their dependency of claims 1 and 13, and that Song does not cure the alleged deficiencies of Ohyama. As shown above, the Examiner maintains that the limitations cited in claims 1 and 13 are sufficiently anticipated by Ohyama. Therefore the 35 U.S.C 103 rejections of claims 7 and 18 are proper and therefore maintained.

***Claim Rejections - 35 USC § 102***

13. Claims 1-6, 8-17, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohyama et al. (US 5,751,373).

See the previous Office Action, dated 12/28/05, and above for the merits of the rejection of claims 1-6, 8-17 and 19-21.

***Claim Rejections - 35 USC § 103***

14. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohyama et al. (US 5,751,373) in view of Song (US 5,691,778).

See the previous Office Action, dated 12/28/05, and above for the merits of the rejection of claims 7 and 18.

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Boddie whose telephone number is (571) 272-0666. The examiner can normally be reached on Monday through Friday, 7:30 - 4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

wlb  
5/22/06



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